

Remarks

This Application has been carefully reviewed in light of the Office Action mailed July 30, 2007. Applicant appreciates the Examiner's consideration of the Application. Applicant believes all claims are allowable without amendment and respectfully provides the following remarks. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. The Claims are Allowable over the Cited Combinations of References

The Examiner rejects Claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2004/004606 by Buttridge et al. ("*Buttridge*") in view of U.S. Patent 6978046 to Robinson et al. ("*Robinson*"). Applicant respectfully traverses these rejections.

A. Independent Claims 1 and 9 and Their Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

1. The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 1

The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claims 1 and 9. Applicant discusses independent Claim 1 as an example.

At a minimum, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in Claim 1:

- in response to receiving the payment information, retrieving, from a storage location, an image replacement document template associated with the checking account; and
- generating an image replacement document representative of the check by inserting the payment information into respective fields of the image replacement document template.

The Examiner acknowledges, and Applicant agrees, that *Buttridge* does not expressly disclose these limitations. (See Office Action at 2-3) However, the Examiner argues that *Robinson* discloses these limitations. (See Office Action at 3) Applicant respectfully disagrees.

For example, the cited portion of *Robinson* does not disclose, teach, or suggest “in response to receiving the payment information, retrieving, from a storage location, an image replacement document template associated with the checking account,” as recited in Claim 1. As allegedly disclosing “an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document,” the Examiner relies on *Robinson*, citing Col. 2, ll. 50-62, the Summary of Invention, and the Abstract. (Office Action at 3) The cited portion of *Robinson* discloses the following:

The systems and methods according to this invention allow the scan/preparation user generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design theme of the document. According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document. In various embodiments, the template is created from a scanned input.

(*Robinson*, Col. 2, ll. 51-61)

However, nowhere does this cited portion disclose, teach, or suggest that in response to receiving payment information comprising a date, a payee, a dollar amount, a legal amount, and a signature, the system disclosed in *Robinson* retrieves an image replacement document from a storage location in response to receiving the payment information, let alone that the system retrieves an image replacement document from a storage location associated with a checking account. Instead, it appears that the cited portion simply discloses creating a document template from a scanned input document. *Buttridge* does not appear to make up for these deficiencies of *Robinson*.

Additionally, nowhere does the cited portion of *Robinson* disclose, teach, or suggest “generating an image replacement document representative of the check,” as recited in Claim 1. Rather, Applicant reiterates that the cited portion appears to simply disclose creating a document template from a scanned input document. Furthermore, it does not appear that the

cited portions of either *Buttridge* or *Robinson* disclose, teach, or suggest inserting any payment information into respective fields of the image replacement document template, let alone the particular payment information recited in Claim 1.

For at least these reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 1. For at least certain analogous reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 9. Independent Claims 1 and 9 and their dependent claims are allowable for at least this reason.

2. The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Dependent Claims 8 and 16

Additionally, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in Applicant's dependent claims. Applicant discusses dependent Claims 8 and 16 as examples, particularly Claim 8. At a minimum, the cited portions of the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in dependent Claim 8:

- generating an image replacement document identification section;
- generating a legal notification section; and
- generating a MICR section representative of the MICR line of the check.

For example, it does not appear that the cited portions of either *Buttridge* or *Robinson* disclose, teach, or suggest "generating an image replacement document identification section," "generating a legal notification section," or "generating a MICR section representative of the MICR line of the check," as recited in Claim 8. It does not even appear to Applicant that the Examiner has addressed with any particularity these limitations recited in Claims 8 and 16. For example, it does not appear that the Examiner has pointed to any portions of *Buttridge* or *Robinson* as allegedly disclosing these limitations recited in Claim 8.

For at least these reasons, the proposed *Buttridge-Robinson* combination does not appear to disclose, teach, or suggest each and every limitation recited in dependent Claim 8. For at least certain analogous reasons, the proposed *Buttridge-Robinson* combination does not

appear to disclose, teach, or suggest each and every limitation recited in dependent Claim 16. Dependent Claims 8 and 16 are allowable for at least this reason.

3. The Proposed *Buttridge-Robinson* Combination is Improper

Applicant respectfully submits that the Examiner has not provided an adequate reason why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Buttridge* and *Robinson* in the manner the Examiner proposes. Applicant's claims are allowable for at least this additional reason.

With respect to the proposed combination of *Buttridge* with *Robinson*, the Examiner states:

[T]he examiner maintains that Robinson system generates an image replacement document representative of any documents. Thus Robinson replacement image document generator can generate an image replacement document representative of a check. Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of *Buttridge* and *Robinson* for users to generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

(Office Action at 3)

Applicant respectfully submits that the Examiner's assertion does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to modify the particular techniques disclosed in *Buttridge* with the cited disclosure in *Robinson*; and (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so.

First, even assuming that *Robinson* discloses that its system generates an image replacement document representative of any documents and that the replacement image document generator can generate an image replacement document representative of a check, as asserted by the Examiner, it is entirely unclear why these disclosures would lead to the conclusion that it would have been obvious to one of ordinary skill in the art to combine the

teachings of *Buttridge* and *Robinson* for users to generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design of the document.

Second, even assuming for the sake of argument only that *Robinson* discloses “in response to receiving the payment information, retrieving, from a storage location, an image replacement document template associated with the checking account” and “generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template,” as argued by the Examiner, it is entirely unclear why one of ordinary skill in the art at the time of Applicant’s invention would incorporate this into the system of *Buttridge*. The system in *Buttridge* scans a physical check at the point of sale and transfers the entire check’s image data to a store controller. *See Buttridge* at [0011]. *Robinson* provides automated creation of a template for a page of an existing document from a scanned input. *See Robinson* at 1:31-33. It is unclear to Applicant why one of ordinary skill in the art would want to generate an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document template when the image document template of a document does not require any insertion of information.

Respectfully, the Examiner’s attempt to combine *Buttridge* with *Robinson* appears to constitute the type of impermissible hindsight reconstruction of Applicant’s claims, using Applicant’s claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the Examiner has not demonstrated the required teaching, suggestion, or motivation to combine *Buttridge* and *Robinson* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner’s conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully submits that the proposed *Buttridge-Robinson* combination is improper. Independent Claims 1 and 9 and their dependent claims are allowable for at least this additional reason.

4. Conclusions with Respect to Claims 1 and 9

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 1. For at least certain analogous reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 9. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 1 and 9 and their dependent claims.

B. Independent Claims 17 and 22 and Their Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

1. The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 17

The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claims 17 and 22. Applicant discusses independent Claim 17 as an example.

At a minimum, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in Claim 17:

- generating a snippet of the payment information; and
- electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet.

The Examiner acknowledges, and Applicant agrees, that *Buttridge* does not expressly disclose these limitations. (See Office Action at 5) However, the Examiner argues that *Robinson* discloses these limitations. (See Office Action at 5) Applicant respectfully disagrees.

For example, the cited portion of *Robinson* does not disclose, teach, or suggest “generating a snippet of the payment information,” as recited in Claim 17. As allegedly disclosing “an image replacement document template, and generating an image replacement document representative of the original document by inserting the information into respective fields of the image replacement document,” which incidentally does not correspond exactly to the limitations actually recited in Claim 17, the Examiner relies on *Robinson*, citing Col. 2, ll. 50-62, the Summary of Invention, and the Abstract. (Office Action at 5) The cited portion of *Robinson* discloses the following:

The systems and methods according to this invention allow the scan/preparation user generate additional and/or replacement pages for an existing document that are visually coherent with the predetermined visual design theme of the document. According to the invention, the creation of additional and/or replacement pages is automated so that manual labor and human errors are reduced. In various embodiments of the invention, the automated page creation is provided by automated creation of a template for a page of the existing document. In various embodiments, the template is created from a scanned input.

(*Robinson*, Col. 2, ll. 51-61)

However, nowhere does this cited portion disclose, teach, or suggest generating a snippet of any payment information [received from an output device].

Additionally, nowhere does the cited portion of *Robinson* disclose, teach, or suggest “electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet,” as recited in Claim 17. The cited portion simply makes no reference to transmitting any information to a remote location, let alone “electronically transmitting the snippet to a remote location for generation of an image replacement document representative of the check based on the snippet,” as recited in Claim 17.

For at least these reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 17. For at

least certain analogous reasons, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 22. Independent Claims 17 and 22 and their dependent claims are allowable for at least this reason.

2. The Proposed *Buttridge-Robinson* Combination is Improper

Applicant respectfully submits that the Examiner has not provided an adequate reason why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Buttridge* and *Robinson* in the manner the Examiner proposes. Applicant's claims are allowable for at least this additional reason.

The Examiner appears to rely on the same argument discussed above with respect to Claim 1 as to why the proposed combination is proper. (Office Action at 5) Applicant reiterates the argument made above with respect to Claim 1 in Section A.3.

Accordingly, since the Examiner has not demonstrated the required teaching, suggestion, or motivation to combine *Buttridge* and *Robinson* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully submits that the proposed *Buttridge-Robinson* combination is improper. Independent Claims 17 and 22 and their dependent claims are allowable for at least this additional reason.

3. Conclusions with Respect to Claims 17 and 22

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 17. For at least certain analogous reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of

obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 22. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 17 and 22 and their dependent claims.

C. Independent Claim 29 and The Dependent Claims are Allowable over the Proposed *Buttridge-Robinson* Combination

1. The Proposed *Buttridge-Robinson* Combination Fails to Disclose, Teach, or Suggest Each and Every Limitation Recited in Claim 29

The proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 29.

At a minimum, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest the following limitations recited in Claim 29:

- generating a snippet of the payment information;
- electronically transmitting the snippet to a remote location;
- electronically receiving the snippet at the remote location;
- in response to receiving the snippet, retrieving, from a storage location, an image replacement document template associated with the checking account; and
- generating an image replacement document representative of the check by inserting the payment information from the snippet into respective fields of the image replacement document template.

The Examiner acknowledges, and Applicant agrees, that *Buttridge* does not expressly disclose these limitations. (See Office Action at 7) However, the Examiner argues that *Robinson* discloses these limitations. (See Office Action at 7) Applicant respectfully disagrees.

For at least certain reasons analogous to those stated in Sections A and B of this document, the proposed *Buttridge-Robinson* combination fails to disclose, teach, or suggest each and every limitation recited in independent Claim 29. Independent Claim 29 and the associated dependent claims are allowable for at least this reason.

2. The Proposed *Buttridge-Robinson* Combination is Improper

For at least certain reasons analogous to those stated in Sections A and B of this document, Applicant respectfully submits that the proposed *Buttridge-Robinson* combination is improper. Independent Claim 29 and the associated dependent claims are allowable for at least this additional reason.

3. Conclusions with Respect to Claim 29

For at least these reasons, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on the proposed *Buttridge-Robinson* combination with respect to independent Claim 29. Thus, for at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 29 the associated dependent claims.

III. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the reference cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

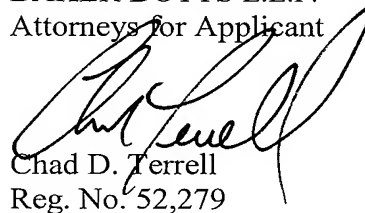
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any necessary fees or credit any overpayments to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant

A handwritten signature in black ink, appearing to read "Chad D. Terrell", is written over the printed name and registration number.

Chad D. Terrell
Reg. No. 52,279

Date: October 30, 2007

CORRESPONDENCE ADDRESS

at Customer No. **35005**